



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Operations

Trademark Law Office 111

Trademark Attorney: Ingrid C. Eulin

Applicant : Itoya of America, Ltd.

Serial No. : 76/498,199

Filed : March 14, 2003

Mark : **XENON**

TTAB

**Attorney's Reference: 31730-187996**

Hon. Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, Virginia 222313-1451

**APPLICANT'S APPEAL BRIEF**

**INTRODUCTION**

This matter is before the Board on Appeal by the Applicant from a final refusal of registration based upon the section 2(d) of the Trademark Act.

**THE RECORD**

The record for this appeal consists of the application, two Office Actions and Responses, a Request for Reconsideration, and the Examining Attorney's denial of the Request for Reconsideration.

**THE EXAMINER'S POSITION**

The Examining Attorney has maintained and made "Final" a refusal of registration based upon Registration Number 2,340,074 issued April 11, 2000 for the mark XENON for "paper and cardboard."



06-08-2005

U.S. Patent & TMO/TM Mail Rcpt Dt. #72

The refusal of registration is based upon the Examining Attorney's contention that "consumers are well accustomed to encountering the applicant's and registrant's goods under the same mark. Hence, they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods come from a common source." (*See Office Action #1 dated September 156, 2003*) In support of this refusal, the Examining Attorney has relied upon a number of third-party registrations which purport to show that "within the relevant market, consumers are well accustomed to encountering both the applicant's and registrant's goods under the same mark and provided by the same source." (*See Office Action #2 dated February 12, 2004*).

In response to Applicant's Request for Reconsideration, the Examining Attorney has submitted evidence obtained from the Internet which purports to show that "packaged paper and cardboard" travel in the same channels of trade as the Applicant's "writing pens."

### **THE APPLICANT'S POSITION**

It is the Applicant's position that there is no confusion between Applicant's mark and Registrant's mark because the goods are sufficiently different.

### **ARGUMENT**

#### **A. The Goods Listed in the Cited Registration Must be Construed as Written**

It is well-settled that likelihood of confusion must be determined on the basis of the goods as they are set forth in the application and cited registration. See e.g., Paula Payne Products, Co. v. Johnson Publishing Co., 177 USPQ 76 (CCPA 1973); In re Chalet Chocolates, Inc., 212 USPQ 968 (TTAB 1982); Ferdinand Mulhens v. Sir Edward Ltd., 214 USPQ 298

(TTAB) 1981; Ziebart International Corp. v. Northern Instruments Corp., 212 USPQ 537 (TTAB 1981).

In the present case, the cited registration covers "'paper and cardboard." It does **NOT** cover "paper" *per se*, it does **NOT** cover "cardboard" *per se*, it does **NOT** cover "goods made of paper," it does **NOT** cover "goods made of cardboard," it does **NOT** cover "paper or cardboard," it does **NOT** cover "goods made of paper and cardboard," and it does **NOT** cover "paper and cardboard products." It covers PAPER AND CARDBOARD as a single product.

A review of the Trademark Acceptable Identification of Goods and Services Manual (*see Exhibit "B" attached to Applicant's Request for Reconsideration*) confirms that "PAPER AND CARDBOARD" is listed as a *single* item. If "paper" and "cardboard" were to be covered as separate items, an appropriate identification might be "PAPER; CARDBOARD" both of which are listed in the Trademark Acceptable Identification of Goods and Services Manual as being acceptable as individual items. (*see Exhibit "B" attached to Applicant's Request for Reconsideration*).

Here, the cited registration does **NOT** cover the individual items "paper" and "cardboard." Rather, the registration covers the individual item "paper and cardboard."

**B. Applicant's Goods and the Goods in the Cited Registration are Not Related**

In the initial Office Action and the "Final" Office Action, the Examining Attorney has simply stated that the Applicant's goods are related to the registrant's goods because there are third-party registrations that list both goods. This analysis is flawed in two respects. First, as indicated above, the cited registration covers the item "paper and cardboard." While all of the noted third-party registrations cover goods of the type listed in this application (*i.e.*, pens), they **DO NOT** also cover goods of the type listed in the cited registration, *i.e.*, "paper and cardboard."

Not one of the noted third-party registrations covers “paper and cardboard.” They may cover items made of paper (e.g., writing paper, paper napkins, paper coasters, paper table cloths, paper mats), but they do not cover the individual item “paper and cardboard” which is the product covered in the cited registration.

Second, even assuming that the third-party registrations relied upon by the Examining Attorney can be interpreted as covering both the Applicant's goods and the registrant's goods, the fact that two items may appear in the same third-party registration should not, in and of itself, be persuasive evidence of a commercial relationship between those items. Applicant respectfully submits that such evidence, without substantially more proof, is insufficient to proof relatedness of the goods.

Under such a standard, it would become virtually impossible to register any trademark. The end result would be that once a trademark is registered for one product, it could never be registered for another product because there is the substantial likelihood that no matter what two goods are involved, there is a third-party registration that covers both.

To illustrate this point, Applicant calls the Board's attention to Exhibit “A” attached to Applicant's Response filed December 9, 2003. That Exhibit comprises copies of use based registrations that would, according to the Examining Attorney's arguments, support the “relatedness” of such diverse goods as

1. Pens and pickles
2. Pens and skateboards
3. Pens and pizza
4. Pens and pizza cutters
5. Pens and cork screws

Clearly, the mere fact that two different items are covered in the same third-party registration is, in and of itself, insufficient evidence of commercial "relatedness" between such products upon which to predicate a refusal of registration under Section 2(d) of the Trademark Act. Third party registrations are simply not evidence of what happens in the marketplace, or that the public is familiar with the use of those marks. NASA v. Record Chemical, 185 USPQ 563 (TTAB).

The Examining Attorney has sought to bolster her argument that the Applicant's goods are related to the registrant's goods with new evidence, submitted together with the Office Action of April 8, 2005. Applicant has reviewed that evidence in great detail, and can find absolutely nothing that supports the Examining Attorney's claims.

Specifically, the Examining Attorney has alleged that "the wording 'paper and cardboard' refers to a type of printing paper supply and can be found in common office supply retailers with other paper products." Applicant's review of the evidence attached to the April 8, 2005 Office Action turned up no reference to a product identified as "paper and cardboard" and no evidence that "paper and cardboard" refers to a type of printing paper supply."

Further, the Examining Attorney's evidence, to the extent that it even remotely references "paper and cardboard," does not show that "paper and cardboard" is "often produced and sold under the same mark as writing supplies similar to applicant's pens." Rather, the evidence merely shows that large office supply stores such as Staples, Office Depot and OfficeMax sell both paper products and pens, but not under the same trademark. For example, the Office Depot printout shows the sale of Cross, Waterman, and Pelikan pens/writing instruments, but not a single paper and cardboard product under any of those marks. Likewise, the OfficeMax printout shows the sale of Hammermill, Xerox and HP paper, and the sale of Sanford, Paper Mate and

OfficeMax pens. It does not show the sale of "pens" and "paper and cardboard" under the same mark.

Where the goods of the parties are different on their face, as they are here, it is necessary to show that the surrounding circumstances or marketing conditions are such that they would be encountered by the same persons under circumstances that would give rise to the mistaken belief that they have a common source. In re American Hoechst Corp., 19 USPQ 947, 947 (TTAB 1983); UMC Industries, Inc. v. UMC Electronics Co., 207 USPQ 861, 879 (TTAB 1980); In re Whittaker Corp., 200 USPQ 54 (TTAB 1978); In re Mack, 197 USPQ 755, 756 (TTAB 1977); Mobay Chemical Co. v. The Standard Oil Co., 163 USPQ 230 (TTAB 1963).

There is absolutely no evidence that the Applicant's "pens" and the registrant's "paper and cardboard" would be encountered by the same persons under circumstances that would give rise to the mistaken belief that they have a common source.

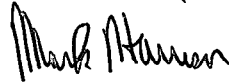
### C. Conclusion

In order to maintain a rejection under Section 2(d), it is not sufficient if confusion is merely "possible." A higher standard is required. See Shatel Corp. v. Mao Ta Lumber & Yacht Corp., 697 F.2d 1352, n.2, 220 U.S.P.Q. 412 (11th Cir. 1983) (likelihood is synonymous with probability); Rodeo Collection, Ltd. v. West Seventh, 812 F.2d 1215, 2 U.S.P.Q.2d 1204, 1206 (9th Cir. 1987) ("Likelihood of confusion requires that confusion be probable, not simply a possibility."); Blue Bell Bio-Medical v. Cin-Bad, Inc., 864 F.2d 1253, 9 U.S.P.Q.2d 1870, 1875 (5th Cir. 1989) ("[Plaintiff] must show, however, that confusion is probable; a mere possibility that some customers might mistakenly identify the [defendant's product] as [plaintiff's] product is not sufficient."). This burden has not been met in this case.

In view of the foregoing, it is respectfully requested that the refusal of registration be reversed.

Respectfully submitted,

By:



---

Mark B. Harrison  
Jacqueline Levasseur Patt  
**Venable LLP**  
P.O. Box 34385  
Washington, D.C. 20045-9998  
Telephone: (202) 344-4019  
Fax: (202) 344-8300

Attorneys for Applicant

Date: June 8, 2005